

Patent
Attorney's Docket No. 024705-077

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Yoshihide HAYASHIZAKI *et al.*

Application No.: 09/254,344

Filed: September 3, 1999

For: RNA POLYMERASE



) Group Art Unit: 1652

) Examiner: R. Hutson

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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In complete response to the Official Action dated July 3, 2001, requiring restriction under 35 U.S.C. §§ 121 and 372, Applicants hereby elect, albeit with traverse, the claims of Group I, claims 1-23 and 25, drawn to an RNA polymerase mutant modified to enhance its ability to incorporate 3'-deoxyribonucleotides and a method for its production.

According to M.P.E.P. § 803, a restriction requirement between patentably distinct inventions is proper only when there is a serious burden on the examiner to examine all the claims in a single application; this is true even when appropriate reasons exist for restriction requirement. The Applicants respectfully submit that the searches required to completely examine the claims would substantially overlap and therefore would be coextensive. In particular, Applicants draw attention to the fact that both groups set forth in the restriction requirement share a special technical feature which is pivotal to the invention. That is, mutations which allow the incorporation of 3'-deoxyribonucleotides. The claims of Group I, which are drawn to an RNA polymerase mutant modified to

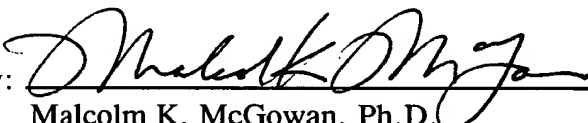
enhance its ability to incorporate 3'-deoxyribonucleotides and a method for its production, are related to the claims of Group II, which is drawn to the polynucleotide encoding the RNA polymerase mutant of Group I. Therefore the search necessary to examine the claims of Group I would substantially encompass that needed to examine the additional claim of Group II. Applicants believe that it would not be an undue burden upon the Examiner to examine all groups of claims at the present time.

Additionally, in a telephonic conversation on July 13, 2001, the Examiner informed the undersigned that the restriction requirement would be withdrawn upon the submission of a certified translation of the Japanese priority application (JP 11075898). Applicants are currently in the process of preparing the necessary translation and will submit it shortly. Applicants respectfully request that the Examiner hold the restriction requirement in abeyance until Applicants submit the necessary documents.

Withdrawal of the restriction requirement, and further and favorable consideration of all the claims of record on the merits is respectfully requested.

Respectfully submitted,

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